

### **REMARKS**

The Office Action mailed on January 15, 2009, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-9 were pending, with claims 5 and 6 being withdrawn from prosecution. By this paper, Applicants do not cancel or add any claims. Therefore, claims 1-9 remain pending.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### **Rejections Under 35 U.S.C. § 102**

Claims 1, 3, 4 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hibi (U.S. Patent No. 4,768,641). In response, in order to advance prosecution, and without prejudice or disclaimer, Applicants hereby amend claim 1, and respectfully submit that Hibi does not anticipate claim 1, and thus does not anticipate any claim that depends from claim 1, for at least the reasons that follow.

Applicants rely on MPEP § 2131, entitled “Anticipation – Application of 35 U.S.C. 102(a), (b), and (e),” which states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Section 103 amplifies the meaning of this anticipation standard by pointing out that anticipation requires that the claimed subject matter must be “*identically* disclosed or described” by the prior art reference. (Emphasis added.) For anticipation, “every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim.” (*Brown v. 3M*, 60 USPQ2d 1375 (Fed. Cir. 2001).) It is respectfully submitted that Hibi does not describe each and every element of any claim now pending.

Claim 1 now recites a conveying device which adds a force, which is caused by increasing a speed difference between a conveying speed of said conveying device relative to a conveying speed of corrugated fins being cut by the recited cutting device, to the corrugated fins cut by said cutting device. This force separates the adjacent corrugated fins from each other to thereby convey the corrugated fins at predetermined intervals. Paragraphs 0042 and 0071 provide exemplary details of an embodiment having this feature. More particularly, in an exemplary embodiment

according to claim 1, the conveying device can separate adjacent corrugated fins that are cut by the cutting device and convey them to a forcible conveying device, which, in an exemplary embodiment, is a device according to the additional features of claim 2. This has the beneficial effect of avoiding and/or reducing the problems related to control exhibited in other devices. (See, e.g., paragraphs 0005, 0007 and 0010.)

The Office Action asserts that Hibi teaches a corrugated fin feeding apparatus comprising a cutting device and a conveying device (12, 20) which adds a force to the corrugated fins being cut to increase a speed thereof to separate the adjacent corrugated fins from each other to thereby convey the corrugated fins at predetermined intervals. However, in contrast, the device (12) of Hibi includes a pair of toothed rollers 12 of the fin forming apparatus (10) which convey an elongated plate 11 (e.g., a blank material for corrugated fins) to the cutting unit (14), as is detailed in Hibi at col. 4, lines 6 - 16. The device (12) of Hibi does not correspond to the conveying device of claim 1, because it only supplies the corrugated fin material to the cutting unit and *it does not add the force to the corrugated fins so as to separate the adjacent corrugated fins from each other in contrast to the invention of claim 1.*

Moreover, in Hibi, the device (20) asserted in the Office Action to correspond to the recited conveying device – the endless conveying belt (21) that conveys the corrugated fins (13) to a rotor (23), as described in col. 4, lines 25-41 of Hibi - does not correspond to the conveying device of claim 1. The conveying belt (21) of Hibi conveys the corrugated fins (13) *at the same speed as that when the corrugated fins (13) are discharged from the forming apparatus (10)* as described in col. 4, lines 31-34.

In view of the above, Hibi cannot anticipate claim 1, and thus anticipates none of the other claims rejected as anticipated, as all of those claims depend either directly or ultimately from claim 1.

### **Rejections Under 35 U.S.C. § 103**

Claims 2, 7 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hibi in view of Bongiovanni (U.S. Patent No. 5,207,083). Applicants submit that none of these claims are obvious in view of the alleged combination.

In rejecting claim 2, the Office Action asserts that Hibi discloses a forcible conveying device (15) which adds a driving force to the corrugated fins being conveyed to push out the corrugated fins toward a downstream side thereof and distributes the corrugated fins in the predetermined directions. The Office Action cites col. 3, lines 22-24 of Hibi, which the Office Action asserts discloses a device that adds a contracting force and drives the corrugated fins 3 to the accumulating device (23). The Office Action further asserts that Bongiovanni discloses a device (48) that controls various devices in a fin forming apparatus using various sensors and programmed control outputs, which allegedly would have been obvious to the ordinary artisan to combine into Hibi.

However, the Office Action is incorrect in asserting that the device (15) of Hibi is a forcible conveying device. The device (15) of Hibi is a contracting unit which contracts the corrugated fins (13) cut to a predetermined length and having a predetermined number of crests in the longitudinal direction of the corrugated fins (13), as is explicitly detailed in Hibi at col. 4, lines 17-21. That is, the device (15) of Hibi shortens the longitudinal length of each corrugated fin by acting the contracting force to the corrugated fin. In addition, the device 15 is provided at the downstream end of the forming apparatus (10) having the cutting unit (14) or at the upstream of the cutting unit (14), as is detailed by Hibi in col. 4, lines 17-24. As is clear from Hibi, the conveying speed of the contracting device (15) needs to be the same as that of the corrugated fins being cut by the cutting device (14).

Further, Bongiovanni teaches a main control (45) and a control circuit (48) where the former controls the latter and a main motor (44) that drives form rolls (22), stuff rolls (32), measuring rolls (44) and the cutout knife (36), while the latter controls a motor (46) of the pullout rolls (42). This means that Bongiovanni teaches control of only one device, (i.e., a corrugated fin forming device). Bongiovanni does not teach control of a plurality of devices nor those controlled based on positions of the corrugated fins determined by conveying device.

Accordingly, claim 2 is not obvious in view of the alleged Hibi-Bongiovanni combination for at least this reason, and thus claims 7 and 8, which depend from claim 2, are likewise not obvious, but there is more.

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The Office Action alleges the obviousness of combining Bongiovanni with Hibi, asserting that “it improves control over the manufacturing, improving quality and allowing for error correction.” (Office Action, page 6, third paragraph.) As no reference is cited for this alleged proposition, the Office Action must be relying on common knowledge in the art, as is discussed and permitted in MPEP § 2144.03, regarding the alleged knowledge of the improved control and error correction. This means that the Office Action is taking *official notice* of certain facts allegedly known to the ordinary artisan. However, there are explicit guidelines that must be followed when taking official notice. For example, the “technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.” (MPEP § 2144.03(B).) *These guidelines are not followed in the Office Action.* Indeed, consider the title of § 2144.03(B): “*If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable.*” No technical line of reasoning is provided in the Office Action whatsoever. All the Office Action does is assert the conclusion of the improved efficiency upon combination, without any support.

Further, Applicants note that § 2144.03(C) allows an applicant to traverse such an assertion. Specifically, § 2144.03(C) is entitled “*If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.*” (Emphasis added.) That section states that when an applicant traverses the assertion, “the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.” (MPEP § 2144.03(C).) Absent a citation by the PTO of a reference that can be evaluated for all its teachings, Applicants hereby traverse and challenge the assertion that it would have been common knowledge in the art that the combination of Bongiovanni with Hibi would have been recognized as improving control over the manufacturing process, improving quality and allowing for error correction. Applicants thus request, relying on § 2144.03, that the PTO cite a reference and exactly identify where such a reference teaches the alleged knowledge in the art, or else allow the claims.

Withdrawal of the rejections of the claims is requested, accompanied with allowance of the application.

**Request for Rejoinder of Withdrawn Claims**

Claims 5-6 stand withdrawn. Applicants respectfully request that these claims be rejoined and allowed due to their similarity to the non-withdrawn claims vis-à-vis the subject matter that renders the non-withdrawn claims allowable. Indeed, such action is concomitant with the indication that “upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.”

Note further that these claims are *method claims drawn to a method paralleling the apparatus of claim 1*. Pursuant to MPEP § 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995), it is respectfully requested that these claim be rejoined and considered, since MPEP § 821.04 states that “when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product.”

**Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith,

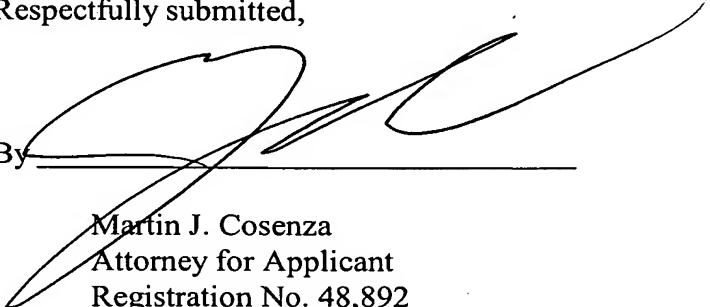
Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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